



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 09/213,131 | 12/15/1998 | ERIC C. ANDERSON | 1104-069 | 7384 |
| 74548 7590 02/02/2010 FlashPoint Technology and Withrow & Terranova 100 Regency Forest Drive Suite 160 Cary, NC 27518 | | | | |
| EXAMINER AGGARWAL, YOGESH K | | | | |
| ART UNIT 2622 | | PAPER NUMBER | | |
| MAIL DATE 02/02/2010 | | DELIVERY MODE PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/213,131

Applicant(s)

ANDERSON, ERIC C.

Examiner

YOGESH K. AGGARWAL

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9, 11-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9, 11-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Response to Arguments

1. Applicant's arguments filed 10/21/2009 have been fully considered but they are not persuasive.

Examiner's response:

2. Applicant argues regarding the first Paragraph rejection according to Chapter 2163 of the M.P.E.P., "While there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." The Applicant submits that the feature of an image capture device not being a scanner is both implicit and inherent in the Specification as originally filed. More specifically, throughout the originally filed application, such as Figures 2-10 and the accompanying description, discussion is made regarding a digital camera 110, the various components of the digital camera 110, and the operation of the digital camera 110. The Applicant submits that as the Specification and the Figures disclose a digital camera, it is inherent that an image capture device is not a scanner. More specifically, as the Specification explicitly discloses a digital camera 110, it necessarily flows that the image capture device cannot be a scanner. The Examiner respectfully disagrees.

The main argument of the Applicant seems to be that since the specification specifies that the image capturing device to be a digital camera, therefore inherently or implicitly it is not a scanner. The Examiner respectfully disagrees. Just because the specification specifies that the capturing device is a camera, it does not mean that it could not be a scanner. In a scanner, similar components are present like a CCD, CMOS or any other image sensors. The heart of all the image capturing devices including cameras and scanners is the imaging sensor (CCD, CMOS or APS) which converts the imaging signals into electrical signals. Therefore there is no reason to

believe that the image capturing device is a scanner or any other capturing device, since the main operation of all these devices is to scan images. The BPAI in affirming the Examiner has agreed with the Examiner on this reasoning (See Page 6 of BPAI decision).

"Examiner found that a scanner is equivalent to a digital camera. Ans. 7. We agree with the Examiner. Claim 7 recites "a method for correcting an aspect ratio of an image captured by an image capture device..., wherein the image capture device is a digital camera." Appellant's Specification does not specifically define the phrase "digital camera." In fact, Appellant's Specification merely indicates that a "[c]amera 110 preferably comprises an imaging device 114, a system bus 116 and a computer 118" (emphasis added). Spec. 7:6-7. Appellant argues that the imaging device typically includes a number of additional components, such as a lens, iris, filter, etc. (App. Br. 8), but Appellant's Specification does not define a digital camera as necessarily including these additional components. Thus, we decline to import these limitations into the claim, and consider the scope of the term "digital camera" to be broad and to encompass a digital imaging device which captures an image and transfers it to a computer".

BPAI has clearly argued that the scanner is analogous to a digital camera in view of Applicant's definition. Therefore the applicant's arguments that the specification implicitly or inherently states that the image capturing device is not a scanner since both the devices have at least an imaging sensor, A/D converter (Parulski) etc. Therefore the 112 first paragraph rejections would be maintained.

Furthermore, by applicant's arguments if a specification does not specify what a device is, it does not inherently or implicitly mean that the device could be anything else than what the specification teaches. In this specification the device is a digital camera or implicitly any other imaging device like a scanner and not any other device that is incapable of carrying out the invention.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 7 and 15 contain negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion.

MPEP 2173.05 (i) states that any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Just because the specification specifies that the capturing device is a camera, it does not mean that it could not be a scanner. In a scanner, similar components are present like a CCD, CMOS or any other image sensors. The heart of all the image capturing devices including cameras and scanners is the imaging sensor (CCD, CMOS or APS) which converts the imaging signals into electrical signals. Therefore there is no reason to believe that the image capturing device is not a scanner or any other capturing device, since the main operation of all these devices is to scan images. The BPAI in affirming the Examiner has agreed with the Examiner on this reasoning (See Page 6 of BPAI decision).

“Examiner found that a scanner is equivalent to a digital camera. Ans. 7. We agree with the Examiner. Claim 7 recites “a method for correcting an aspect ratio of an image captured by

an image capture device..., wherein the image capture device is a digital camera." Appellant's Specification does not specifically define the phrase "digital camera." In fact, Appellant's Specification merely indicates that a "[c]amera 110 preferably comprises an imaging device 114, a system bus 116 and a computer 118" (emphasis added). Spec. 7:6-7. Appellant argues that the imaging device typically includes a number of additional components, such as a lens, iris, filter, etc. (App. Br. 8), but Appellant's Specification does not define a digital camera as necessarily including these additional components. Thus, we decline to import these limitations into the claim, and consider the scope of the term "digital camera" to be broad and to encompass a digital imaging device which captures an image and transfers it to a computer".

BPAI has clearly argued that the scanner is analogous to a digital camera in view of Applicant's definition. Therefore the applicant's arguments that the specification implicitly or inherently states that the image capturing device is not a scanner is not valid since both the devices have at least an imaging sensor, A/D converter (Parulski) etc. Therefore the 112 first paragraph rejections would be maintained.

Furthermore, by applicant's arguments if a specification does not specify what a device is, it does not inherently or implicitly mean that the device could be anything else than what the specification teaches. In this specification the device is a digital camera or implicitly any other imaging device like a scanner and not any other device that is incapable of carrying out the invention.

4. The dependent claims 8, 9 and 11-14, 16, 17, 18 and 20-22 are rejected by virtue of their dependency from claims 7 and 15.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOGESH K. AGGARWAL whose telephone number is (571)272-7360. The examiner can normally be reached on M-F 9:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571)-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yogesh K Aggarwal/

Application/Control Number: 09/213,131

Page 7

Art Unit: 2622

Primary Examiner, Art Unit 2622